

DETAILED ACTION

This is a First Action on the Merits. Claims 1-29 are pending.

Election/Restrictions

1. Applicant's election without traverse of claims 1-4, 11-15 and 20-28 in the reply filed on 25 January 2008 is acknowledged.

Priority

2. It is noted that this application appears to claim subject matter disclosed in prior Application No. 02.00213, filed 09 January 2002, 60/363,552 filed 13 March 2002 and PCT/FR03/00025 filed 07 January 2003. A reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c). See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, 121, or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the

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application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was

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due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

Claim Objections

3. **Claims 1, 4, 11, 13, 14 and 24-28** are objected to because of the following informalities:

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Claim 1: applicant claims the limitation "and/or" two times in line 17. The claim should be amended to "and" or "or" as "and/or" is a vague term.

Claims 4 and 26-28: applicant claims the limitation "at least substantially" (e.g. claim 26, line 3. The limitation is vague as the portion "at least" indicates a minimum permissible value and the limitation "substantially" indicates a value that may be more or less than the permissive value. For example, Claim 26, the value is 50 cm. The limitation "at least...50 cm" is interpreted to mean 50 cm is the absolute minimum, and "substantially equal" is interpreted to include values that can be greater or less than that value. Appropriate correction is required.

Claim 11: applicant claims "the assembly point" (line 4). There is lack of antecedent basis for the limitation.

Claim 13: applicant claims "the elements for assembly" (line 2). There is lack of antecedent basis for the limitation.

Claims 14, 24 and 25: applicant uses improper Markush terminology in listing items in a series. The proper terminology is "consisting of...and" or "is...or" (e.g. alpha is selected from the group consisting of X, Y and Z...) See MPEP § 2173.05(h).

Claim 25: applicant claims the limitation "etc." in the series (line 13). This is a vague term as etc. can be open-ended to include virtually any material.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 15 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4 and 15: applicant claims the limitation "it" (claims 4 and 15, line 2, see "where it comprises".) It is unclear to the examiner what "it" references and must be corrected.

Claim 4: the limitation regarding the dimensions of the tile (lines 3 and following) are vague and confusing as applicant appears to be claiming ratios of the lengths and widths. The limitations should be clarified.

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Claim 27: applicant claims a range within a range in the same claim (i.e. "between 1 cm and 25 cm, preferably between 5 cm and 15 cm,"). This is vague and indefinite as it is unclear whether the limitation desired is "between 1 cm and 25 cm" or "between 5 cm and 15 cm". For one acceptable correction, the examiner suggests deleting "preferably between 5 cm and 15 cm".

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 11-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Hamar (U.S. Patent No. 4,538,392).

Claim 1: Hamar discloses a modular floor comprising tiles (Fig. 2) and at least one series of tile framing modules (32, 34) that are rigid in at least one plane, the modules are able to frame the tiles, which has openings of dimensions at least substantially identical to those of the tiles (see where module 32 is placed at each end of the tile, and which prior to

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attachment of members 24, would be open and the dimensions would be substantially identical to those of the tiles, the framing modules have means for detachable assembly (Fig. 3: 80, 82) of the framing modules with one another and the means for detachable assembly allow the modules to be removed by manipulating the module, the tile and the module adjacent to it. The language "be able...said tiles" lines 6 and 7; "adapted to impose...in at least one plane" lines 10 and 11 and "adapted to allow...adjacent to it" lines 12-16 are statements of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Claim 2: a first framing module can be dissociated from the framing modules by displacing in a vertical direction

Claim 3: the framing modules (32) are a straight strip.

Claim 4: the covering has rectangular tiles with a series of identical modules (Fig. 2, generally), having a general shape of a straight strip, and a second series of identical modules (Fig. 2) having a general shape of a straight strip of a length at least substantially equal to the sum of the other side of the tiles and the width of a module of the first series (as

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best understood by the examiner: see Fig. 2 where one module is in the shape of a rectangle and another is in the shape of a square.)

Claim 11: the means for detachable assembly of two adjacent modules comprise a rigid element (Fig. 7: 82, 86) formed of two legs that fit under one side framing module (portion 34) and into a lower receptacle (Fig. 9: proximate 80) of the first module extending from the assembly point, the other leg fits under the other of the framing module (portion 34) extending from the assembly point.

Claim 12: the receptacle (proximate 80) extends mainly in a longitudinal direction of the strip.

Claim 13: the elements for assembly (82, 86, as best understood by the examiner) are right angled. The language "for assembly...framing modules" is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Claim 14: the elements for assembly (tongue portion 28) are a straight bar. The phrase "for assembly...framing modules" Is a statement of intended use of the claimed invention and must

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result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Claim 15: detachable locking means (see screws in Figure 9), passing through a framing module (Fig. 9: 32) and one leg of the assembly element. The phrase "capable of...assembly element" is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for

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establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hamar in view of Counihan (U.S. Patent No. 6,164,031).

Claim 20: the prior art of record discloses the claimed invention except that the framing modules are made of metal (see rejection of claim 1 above for explanation of receptacles.) Counihan discloses a flooring system with metal framing members (26). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to make framing modules (Hamar portion 22) out of metal as a matter of functional equivalence that would perform equally as well as the wood strips.

Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamar in view of Counihan and Virtanen (U.S. Publication 2002/0073640).

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Claims 21 and 22: the prior art of record discloses the claimed invention except for elastic damping means made of foam material. Virtanen discloses a flooring system with foam damping means (3). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to have damping means because damping means are well known in the art for desired reduction of vibrations. The language "injection moulded" references method limitations and only the final product (foam) is provided patentable weight.

Claims 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamar in view of Hamar (U.S. Patent No. 5,987,839).

Claim 23: Hamar '392 discloses the claimed invention including the members are made of wood, but it does not disclose a plurality of superposed sheets. Hamar '839 discloses a flooring member made of plywood, which is made of superposed sheets. It would have been obvious at the time the invention was made to a person having ordinary skill in the art because plywood is a type of wood and would perform equally as well for flooring in Hamar '392.

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Claim 24: the lower take up sheet (portions beneath the upper laminate sheet) is compressed particulate material (it is plywood which is compressed particulate material.)

Claim 25: the upper finishing sheet is made of plywood, which is a laminate.

Claims 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamar.

Claims 26-28: the prior art of record discloses the claimed invention except for the limitations of the dimensions as claimed (including the dimensions of the strips and thickness of the framing module,) though Hamar does disclose that the floor may be constructed to any predetermined dimension (Col. 2, lines 40-50). It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have the dimensions as claimed because applicant failed to state a criticality for the necessity of the limitation and the prior art of record is capable of being designed to meet the limitation as claimed.

See MPEP 2144.04(IV) (A) citing *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338 (Fed. Cir. 1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a

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device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William V. Gilbert whose telephone number is 571.272.9055. The examiner can normally be reached on Monday - Friday, 08:00 to 17:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571.272.6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. V. G./
Examiner, Art Unit 3635
/Basil Katcheves/
Primary Examiner, Art Unit 3635